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EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,733

Applicant(s)

COOPERMAN ET AL.

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 18, 19 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ☉
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ 0
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Claim Objections

1. Claims 1-24 are objected to because of the numbering of the claims is misnumbered and are renumbered 1-26 .

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "in said in an icon " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 12 is rejected under 35 U.S.C. 102(e) as anticipated by Wick (US Patent 6,691,162).

As to claim 12, Wick discloses a method for providing a notification that a request to initiate an instant messaging conversation has been received [Fig. 9, shows a received message, comprising:

receiving the request to initiate an instant messaging [Fig. 9, shows a received message]; and

in response to receiving said request, displaying a notification window comprising an identification of an instant messaging user associated with said instant messaging and said instant messaging [Fig. 9, shows a notification window that pops up as the user signs an IM, the window has a text display area 93 showing the identity 91 of the IM sender (identification of IM user associated with said instant message) and the message 92].

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

* (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1- 6,25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162) in view of Flanagan et al (US Patent 6,292,769) .

As to claim 1, Wick discloses receiving said request to initiate an instant messaging [Fig. 9, shows a received window for chatting]; and

in response to receiving said request, displaying a notification window comprising an identification of an instant messaging user associated with said request [Fig. 9, shows a notification window that pops up as the user signs an IM, the window has a text display area 93 showing the identity 91 of the IM sender (identification of IM user associated with said instant message) and the message 92].

Wick discloses an instant messaging system for inviting another user to participate (col. 6, lines 8-13).

Wick does not disclose explicitly a topic for said instant messaging conversation.

Flanagan discloses an instant messaging (IM) system for chatting where the user selects a topic (col. 12, line 59-col. 13, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Flanagan's teachings to modify Wick's method by using a topic for chatting in an instant message in order to collaborate with another user in a way second only to real human contact.

As to claim 2, Wick further discloses that parameters could be specified for the actions to be taken i.e sent IM, audible or visual notification (col. 5, lines 10-18). Wick does not explicitly disclose wherein displaying the notification window comprises gradually displaying the notification window.

However, gradually displaying the notification window is obvious in view of visual notification in order to alert the user of receiving an IM.

As to claim 3, Wick further discloses wherein the notification window is displayed proximate to an icon associated with an instant messaging client application [Fig. 10, shows notification window 112, proximate to buttons 118 (icons) associated with IM user application].

As to claim 4, Wick further discloses wherein said notification window is displayed proximate to an icon associated with said request to initiate an instant

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messaging conversation [Fig. 10, the send buttons (icons) which initiates IM conversation is displayed proximate to notification window 112].

As to claims 5 & 6, Wick further discloses wherein the icon is displayed in a task bar located along one edge of a user interface desktop [Fig. 10, 118 is task bar that displays the buttons 118 (icons)].

As to claim 25, refer to claim 1 rejection.

As to claims 26, refer to claim 1 rejection.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162) in view of Flanagan et al (US Patent 6,292,769) , as applied to claim 1 and further in view of Wishoff (US 2002/0080184).

As to claim 7, Wick further discloses further comprising:

determining whether a request has been received to respond to said request to initiate an instant messaging conversation [col. 6, lines 54-59];

Neither Wick nor Flanagan disclose in response to determining that the request has not been received within a predetermined amount of time, removing the notification window.

Wishoff discloses a system for providing a GUI which displays a notification window when the user receives a message (col. 4, [0060]). When the system does not receive a response from the user with a predetermined time, it logs the user off (remove the notification window) (col. 8, [0144]) .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wishoff's teachings to modify the combined Wick's

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method and Flanagan by removing the notification window after a specific period of time in order to prevent users inadvertently leaving their accounts open to inappropriate use by others.

As to claim 8, refer to claim 2 rejection.

As to claim 9, Wick further discloses wherein the identification of the instant messaging user associated with the request and the topic for the instant messaging conversation may be selected until the notification window is completely removed (col. 6, lines 44-59).

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162).

As to claim 13, refer to claim 2 rejection.

As to claims 14&15, refer to claim 3 rejection.

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162), as applied to claim 1 and further in view of Wishoff (US 2002/0080184).

As to claim 16, Wick does not disclose further comprising determining whether said instant message is intended for an instant messaging client application window that is not a visible window or that is not a foreground window; and

in response to determining that said instant message is intended for a non-visible or non-foreground window, displaying said notification window as a visible foreground window.

Wishoff discloses a system for providing a GUI which displays notification

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window when a message is received (col. 4, [0060]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wishoff's teachings to modify the combined Wick's method by bringing messaging client application window to foreground in order to collaborate with another user in a way second only to real human contact.

As to claim 17, Wick further discloses further comprising scrolling the instant message in the in an icon associated with the instant messaging user [Fig. 10, shows notification window 112, proximate to buttons 118 (icons) associated with IM user application].

11. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162), and further in view Network Magazin. Com, Instant Gratification.

As to claim 20, refer to claim 1 rejection for their common features. Wick discloses an instant messaging system but does not disclose a business partner.

Network magazine.com discloses that instant messaging system are used by business and companies (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Network magazine.com's teachings to modify the combined Wick's method by using instant messaging in business messages in order to communicate with a business partner in a way second only to real human contact.

As to claim 21, refer to claim 2 rejection.

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As to claim 22, Network Magazin. Com further discloses directing a web browser to a web site associated with the business partner in response to the selection of the identification of the business partner or the instant message [page. 2, lines 3-15].

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wick (US Patent 6,691,162), and further in view Network Magazin. Com, Instant Gratification, as applied to claim 21 and further in view of Wishoff (US 2002/0080184).

As to claim 23, neither Wick nor Network Magazin. Com discloses determining whether a selection of the identification of the business partner or the instant message was received within a predetermined amount of time; and in response to determining that the selection was not received, gradually removing the notification window.

Wiskoff discloses a system for providing a GUI which displays a notification window when the user receives a message (col. 4, [0060]), when the system does not receive a response from the user with a predetermined time, it logs the user off (remove the notification window) (col. 8, [0144]) .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wishoff's teachings to modify the combined Wick's method and Network Magazin. Com by removing the notification window after a specific period period of time in order to prevent users inadvertently leaving their accounts open to unappreciated use by others.

Allowable Subject Matter

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14. Claims 10-11, 18-19, 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (703) 305-9705. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hieu Le


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER